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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/748,621

12/30/2003

Frank L. Neely

VTN 568CIP1

7509

27777

7590

12/11/2008

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EXAMINER

WEBB, WALTER E

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

12/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/748,621	<b>Applicant(s)</b> NEELY ET AL.	
	<b>Examiner</b> WALTER E. WEBB	<b>Art Unit</b> 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-15,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12-15,28 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/23/2008</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicants' arguments, filed 9/19/2008, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### ***Claim Rejections - 35 USC § 103***

Claims 1, 3-10, 12-15 and 28-29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sakuma et al., (US 5,213,801) in view of Nochumson, (US 4,542,200) and in further view of Vanderlaan et al.

Applicant argues unexpected results in regard to the ratio of silver to ligand monomer, stating that the data of Table 2 on page 23 "clearly shows that as the silver:ligand ratio increases, the efficacy of the resultant lens also increases." However, applicant's argument is unpersuasive insofar as the data of Table 2 are not drawn to the prior art ligand monomer, which was elected by applicant in response to a restriction requirement. These data are not probative insofar as they do not deal with the specific prior art that was the subject of the rejection.

Applicant further argues that Sakuma, Nochumson, and Vanderlaan do not teach the ratio of silver to ligand. However, it was determined that the amount of silver and ligand monomer incorporated into the contact lens of Sakuma was simply a matter of routine optimization. Furthermore, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Applicant also argues that Vanderlaan does not disclose senofilcon A. However, applicant states in the specification (page 11, lines 22-25) that the preferable contact lens formulation of senofilcon A, for example, can be prepared as in US 5, 998, 498, i.e. Vanderlaan. This shows that Vanderlaan is a proper reference for senofilcon A.

### ***Obvious-type Double Patenting***

Claims 1, 3-10, 12-15, and 28-29 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 8-13, 15-27 and 42-44 of copending Application No. \*10/703,777.

\* It is noted here that the proper Application number is 10/703,770.

Applicant argues that that the '770 application claims a ratio of at least about 0.45. However, in regard to the term "about", the courts have recently begun to interpret the term far more expansively. See, e.g., Conopco v. May, 24 USPQ2d 1721, 1736 (U.S. District Court, Eastern District of Missouri 1992), where four times was found within scope of "about", where the components of the respective compositions perform substantially the same function in substantially the same manner. The '770 application claims a ratio of about 0.45 and the instant application claims a ratio of about 0.8 are close enough to be within the scope of each other and are therefore obvious.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter E. Webb whose telephone number is (571) 270-3287. The examiner can normally be reached on 8:00am-4:00pm Mon-Fri EST.

Art Unit: 1612

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Walter E. Webb  
/Walter E Webb/  
Examiner, Art Unit 1612

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612